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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,520	11/16/2005	Hideji Tajima	4986-0103PUS1	9089
2292	7590	05/12/2009	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				BOWERS, NATHAN ANDREW
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
05/12/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/531,520	TAJIMA ET AL.	
	Examiner	Art Unit	
	NATHAN A. BOWERS	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 February 2009.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.
 4a) Of the above claim(s) 19-30 and 37-40 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-18,31-36 and 41 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 14 April 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>041405</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1) Claims 1-18, 31-36 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "large" in claims 1-18, 31-36 and 41 is a relative term which renders the claim indefinite. The term "large" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Those of ordinary skill would have differing opinions regarding what number constitutes a "large" number of magnetic supports. Furthermore, one's conception of "large" may be based either on total quantity or concentration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 2) Claims 1 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan (US 5753477).

With respect to claim 1, Chan discloses an apparatus for introducing a biological material which has one or more packing units capable of accommodating a plurality of cells and a mixture solution containing magnetic supports carrying a biological material. This is disclosed in column 5, line 42 to column 6, line 59. Column 4, lines 32-62 state that an introduction treatment unit is used to control a magnetic force affecting the inside of the packing unit from at least two directions so as to move the magnetic supports relative to the host cells in order to introduce the supports and biological material into the host cells.

With respect to claim 4, Chan discloses the apparatus in claim 1 wherein the magnetic supports have a major axis and a size allowing entry into the host cells. Column 5, lines 1-40 indicate that the supports are ideally situated for cell penetration.

With respect to claim 5, Chan discloses the apparatus in claim 1 wherein an introduction adjuvant for helping to introduce the biological material is provided. In column 5, lines 33-40, Chan indicates that the magnetic supports are coated with a biologically inert material in order to improve and facilitate transfection.

With respect to claim 6 and 7, Chan discloses the apparatus in claim 1 wherein the apparatus is fully capable of manipulating magnetic supports of essentially any shape compatible with cell penetration. The packing unit and introduction treatment unit of Chan are fully capable of interacting with a wide variety of magnetic supports.

With respect to claim 8, Chan discloses the apparatus in claim 1 wherein the introduction treatment unit performs introduction treatment based on the properties, amount and density of the host, biological material and magnetic supports.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3) Claims 2, 3, 9, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan (US 5753477) in view of Dzekunov (US 20030073238).

With respect to claims 2 and 3, Chan discloses the apparatus set forth in claim 1. Chan discloses that a magnetic source is used to apply a magnetic field capable of moving the magnetic supports relative to the host cells. Chan, however, does not expressly state that the magnetic source is controlled using a control unit.

Dzekunov discloses a flow cell adapted for the transfection of biological cells with foreign matter. A flow channel (Figure 13:40) is provided in communication with electrode plates (Figure 13:10) configured to create an electrical field capable of porating a cell. This is described in paragraph [0249]. Paragraphs [0199] and [0200] indicate that the operation of the system is regulated using a control unit.

Chan and Dzekunov are analogous art because they are from the same field of endeavor regarding the introduction of biomolecules into biological cells.

At the time of the invention, it would have been obvious to ensure that the magnets of Chan are operated using a control unit. As evidenced by Dzekunov, automatic controllers are considered to be well known in the art, and useful for the regulation of a complex system. One of ordinary skill would have recognized that control units are efficient, cost effective and capable of operating a particular unit (such as a magnet) with a high degree of precision and accuracy.

With respect to claim 9, Chan discloses the apparatus set forth in claim 1. Although Chan does indicate that the host cells and magnetic particles are accumulated within an enclosed packing unit, Chan does not expressly teach that the packing unit has a liquid passage and a pressure adjuster.

Dzekunov discloses the apparatus as previously described above. Dzekunov teaches that cells are porated within a liquid passage (Figure 13:40), and that the fluid flow through the passage is regulated using a plurality of valves and pumping means. The valves and pumping means of Dzekunov serve as pressure adjusters because they are used to increase and decrease the fluid pressure within the passage at any given time.

At the time of the invention, it would have been obvious to construct the Chan apparatus as a flow chamber system comprising a liquid passage suited for communication with the introduction treatment unit. Dzekunov teaches it is desireable to provide a flow cell with valves and pumps capable of regulating and correcting the pressure during experimentation. One of ordinary skill in the art would have understood that the apparatus of Chan naturally calls for accumulating cells and magnetic particles within a packing unit formed as a liquid passage, modifying the cells by applying a magnetic force, and then removing the modified cells from the flow chamber through the operation of valves and pumps.

With respect to claims 31-36, Chan discloses an apparatus for introducing a biological material which has one or more packing units capable of accommodating a plurality of cells and a mixture solution containing magnetic supports carrying a biological material. This is disclosed in column 5, line 42 to column 6, line 59. Column 4, lines 32-62 state that an introduction treatment unit is used to control a magnetic force affecting the inside of the packing unit from at least two directions so as to move

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the magnetic supports relative to the host cells in order to introduce the supports and biological material into the host cells. Chan, however, does not expressly state that a perforation treatment unit is provided.

Dzekunov discloses a flow cell adapted for the transfection of biological cells with foreign matter. A flow channel (Figure 13:40) is provided in communication with electrode plates (Figure 13:10) configured to create an electrical field capable of porating a cell. This is described in paragraph [0249]. The electrode system is considered to be a perforation treatment unit because it is used to electroporate cell membranes.

At the time of the invention, it would have been obvious to provide the Chan system with an electroporation system similar to that set forth by Dzekunov. Dzekunov teaches that electroporation is a useful technique that allows one to reversibly porate a plurality of biological cells in solution without permanently damaging the cell membrane. One of ordinary skill would have found it beneficial to first porate the host cells in Chan through the creation of an electric field before puncturing them with the magnetic supports. This would have reduced the trauma experienced by the cells and would have improved transfection frequency.

- 4) Claims 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan (US 5753477) as applied to claim 1, and further in view of Lafferty (US 20030096220).

With respect to claims 10-12, Chan discloses the apparatus set forth in claim 1, however does not expressly indicate that a plurality electromagnets are provided in communication with a transfer element for movement around the packing unit.

Lafferty discloses a capillary device for screening biological analytes comprising a plurality of magnets capable of interacting with magnetic beads within the capillary. Lafferty teaches in paragraph [0380] that a plurality of magnet blocks are provided in communication with the capillary, and are capable of being mechanically moved up and down the capillary using a plurality of holders. This is depicted in Figure 7B.

Chan and Lafferty are analogous art because they are from the same field of endeavor regarding the manipulation of magnetic particles in microfluidic biological testing devices.

At the time of the invention, it would have been obvious to provide the Chan system with a plurality of magnet blocks capable of being moved relative to the packing unit. Lafferty teaches that varying the distance and location of magnetic blocks in relation to suspended magnetic particles in a solution allows one to better affect the motion of the magnetic particles. The use of a plurality of magnetic blocks operated by mechanical holders would have allowed given one an enhanced ability to manipulate the magnetic supports of Chan so as to better effectuate transfection. The addition of multiple magnetic blocks and corresponding holders to the Chan system would be completed in a predictable manner and would yield predictable results.

With respect to claim 13, Chan discloses the apparatus set forth in claim 1, however does not expressly indicate that the magnet source is an annular magnet source capable of movement along the packing unit. As noted above, Lafferty discloses a plurality of mechanical moving means capable of transporting magnet blocks across the length of a capillary tube in order to affect magnetic supports within the tubes. Although Chan and Lafferty each fail to disclose the use of annular magnets, one of ordinary skill would have understood to form the magnets of Chan according to any known shape capable of providing attractive and repulsive forces to the supports in solution. The use of an annular magnet is functionally equivalent to the use of magnets formed as other shapes, and therefore the use of an annular magnet is not patentably distinguishable over the prior art. See MPEP 2144.04.

With respect to claims 14-16, Chan discloses the apparatus set forth in claim 1, however does not expressly disclose the use of a plurality of packing units arranged along a horizontal line, and a plurality of magnetic sources configured to interact with the plurality of packing units. As set forth above, Lafferty discloses a plurality of capillary tubes (see Figure 7B) arranged in parallel, and a plurality of magnet blocks each capable of communicating with a respective tube and moving across the length of a respective tube.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to operate a plurality of the Chan packing tubes in parallel so that each packing unit is operated simultaneously by a respective magnet block. One of ordinary skill

would have understood that this arrangement would have been beneficial because it would have served to increase throughput and improve efficiency.

5) Claims 17, 18 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan (US 5753477) as applied to claim 1, and further in view of Blankenstein (US 20030044832).

Chan discloses the apparatus set forth in claim 1, however does not expressly indicate that a magnetic separation unit is provided for isolating magnetic particles.

Blankenstein discloses a magnetic separation unit comprising a packing unit through which magnetic supports (Figure 1:12) and non-magnetic particles (Figure 1:13) are allowed to flow. A magnet (Figure 1:8) is provided for separating the magnetic supports from the remainder of the mixture solution by causing the magnetic supports to deviate toward a different fluid outlet (Figure 1:6). This is disclosed in paragraph [0132].

Chan and Blankenstein are analogous art because they are from the same field of endeavor regarding magnetic manipulation of biological particles.

At the time of the invention, it would have been obvious to provide the packing unit of Chan with a magnetic separation unit capable of recovering and isolating host cells transfected with a magnetic support. Blankenstein is evidence that one of ordinary skill would have been able to use a magnetic separation unit in the system of Chan in order to efficiently and accurately separate transfected cells for undesirable components within the fluid mixture. One of ordinary skill would have found this to be a desirable way to quickly isolate the magnetic supports for further downstream processing.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Hatakeyama (US 7465579) reference discloses the state of the art regarding the use of a packing unit, a magnetic introduction unit, and a perforation unit. Hatakeyama, however, is not prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN A. BOWERS whose telephone number is (571)272-8613. The examiner can normally be reached on Monday-Friday 7 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 1797

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Examiner, Art Unit 1797